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09/733,286	12/08/2000	Allan A. James	60366	2977

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THE DOW CHEMICAL COMPANY
INTELLECTUAL PROPERTY SECTION
P. O. BOX 1967
MIDLAND, MI 48641-1967

EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 19

Application Number: 09/733,286
Filing Date: December 08, 2000
Appellant(s): JAMES ET AL.

John Wilson Jones
For Appellant

MAILED

FEB 25 2004

GROUP 1, 30

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 2, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellants' statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellants' statement of the issues in the brief is correct.

(7) *Grouping of Claims*

With respect to the rejection under 35 U.S.C. 102(b), appellants' brief includes a statement that claims 18 and 24 do not stand or fall with claims 17, 21-23, 25, and 35 and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

With respect to the rejection under 35 U.S.C. 103, appellants' brief includes a statement that claims 19, 33, 34, and 36-45 stand or fall together.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

WO 96/22182	Muenstermann	July 25, 1996
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U.S. 5,525,681	Barron et al.	June 11, 1996
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(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17, 18, 21-25, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 96/22182.

The reference discloses the production of reaction injection molded polyureas that contain jojoba oil in the instantly claimed amounts. A calculation of the content of jojoba oil within the examples of the reference, based on the weight of the A-side, is 1.53% by weight.

This value fully meets appellants' claimed value. Additionally, see abstract and pages 4+. Since the reference discloses the production of compositions that are derived from components and amounts of the components that meet the claims, the position is taken that the prior art compositions inherently possess the anti-blistering characteristics of the instant compositions. Contrary to appellants' argument at pages 5 and 6 of the Appeal Brief, the position is taken that the aforementioned rationale constitutes adequate technical reasoning to support the position that the prior art compositions inherently possess an anti-blistering characteristic. It is noted that appellants' claimed moisture and temperature conditions are not requirements of the claimed process; they are merely conditions set forth for comparing the anti-blistering characteristics of products containing the jojoba oil component and products lacking the jojoba oil component. Accordingly, it follows that the products of the prior art containing the jojoba oil component in the instantly claimed amounts would inherently possess or display the anti-blistering characteristic under these conditions.

Appellants have argued that blister resistance is not inherent to the compositions of the prior art; however, appellants have provided no evidence that the prior art product does not necessarily or inherently possess the characteristics, namely the anti-blistering characteristic, of the instant product. *Ex parte Granna*, (BPAI 1989) 10 USPQ2d 1982.

Appellants have argued at page 4 of the Appeal Brief that the examiner has failed to recognize that the present invention is a proper method of use claim, and appellants have further argued that claims directed to a method of use are patentable if the claimed usage is previously unknown. In response, the instant situation is deemed to be fully analogous to a situation where

the court has held that a process patent is anticipated by a reference that teaches a process that produces a product having the same properties, even though the prior art did not recognize that it possessed them or differs in a process parameter not set forth in the claims. *Verdegaal Bros. v. Union Oil of Calif.*, (CAFC 1987) 814 F2d 628, 2 USPQ2d 1051.

With respect to claim 18, appellants have argued the reference fails to recite an isocyanate index between 1.05 and 1.40. In response, the examples of the reference disclose index values of 1.20, 1.10, 1.10, and 1.10 at line 19 of page 13, line 18 of page 14, line 18 of page 15, and line 17 of page 16, respectively.

With respect to claim 24, appellants have argued that the reference fails to disclose that the polyurea takes up no more than two weight percent water when exposed to moisture. In response and as set forth within the advisory action of October 25, 2002, this characteristic is considered to be an inherent property of the disclosed polyurea. This position is reasonable in view of the fact that polyureas are known to be hydrophobic and further in view of the fact that one would expect the hydrophobic jojoba oil to further increase the hydrophobicity of the polyurea.

Claims 19, 33, 34, and 36-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/22182 in view of Barron et al. ('681).

As aforementioned within the body of the above anticipation rejection, the primary reference discloses the production of reaction injection molded polyurea compositions containing jojoba oil in amounts that appellants claim.

However, the primary reference fails to specifically recite the production of automobile parts and the addition of polyepoxide to the polyureas. With respect to the former difference, Barron et al. disclose that automobile parts are fabricated from polyurea RIM compositions. See column 1, lines 24-26. The use of RIM methods to produce automobile components was, in fact, conventional at the time of invention. Therefore, it would have been obvious to produce automobile parts utilizing the RIM method of WO 96/22182. With respect to the latter difference, the addition of polyepoxide to polyurea compositions, suitable for use in RIM methods, was known at the time of invention as an effective means for decreasing the formation of blisters resulting from exposure to moisture and elevated temperatures. This position is fully supported by the teachings of Barron et al. See abstract and columns 1 and 2. Therefore, it would have been obvious to incorporate polyepoxide into the compositions of the primary reference for the art recognized function of decreasing blistering within RIM polyureas.

Contrary to appellants' argument at page 8 of the Appeal Brief, the examiner has set forth the requisite motivation for combining the teachings of the references. Specifically, it has been shown that it is *prima facie* obvious to produce automobile parts from RIM polyurea, and a clear motivation has been set forth for incorporating polyepoxide into a RIM polyurea.

Lastly, appellants have again argued that the combined references fail to set forth the moisture and temperature conditions set forth within the claims. However, it is again noted that appellants' claimed moisture and temperature conditions are not requirements of the claimed processes; they are merely conditions set forth to aid in defining the amount of jojoba oil necessary to yield the anti-blistering characteristic. Since it has been established that the primary

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reference sets forth an amount of jojoba oil that meets the claims and the examples of the instant invention, the position is taken that the products of the prior art inherently possess or display the anti-blistering characteristic at the argued conditions.

(11) Response to Argument

Appellants' arguments have been addressed within the *Grounds of Rejection*.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Rabon Sergent
Primary Examiner
Art Unit 1711

R. Sergent
February 7, 2004

Conferees:



Supervisory Patent Examiner James Seidleck



Supervisory Patent Examiner David Wu

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